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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/138,209 08/24/98 POEL

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HM12/1031  
PHARMACIA & UPJOHN COMPANY  
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EXAMINER

COLEMAN, B

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

10/31/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/138,209

Applicant(s)

POEL et al.

Examiner  
Brenda Coleman

Group Art Unit  
1624



☒ Responsive to communication(s) filed on Oct 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-6, 8, and 11-15 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-5, 8, and 11-15 is/are allowed.

☒ Claim(s) 6 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

Claims 1-6, 8 and 11-15 are pending in the application.

This action is in response to applicant's amendment filed October 6, 2000. Claim 1 has been amended; claims 7, 9 and 10 have been canceled; and claims 14 and 15 are newly added.

#### *Response to Amendment*

Applicant's arguments filed October 6, 2000 have been fully considered with the following effect:

1. The applicant's amendments are sufficient to overcome the improper Markush rejection of the last office action, which is hereby **withdrawn**.
2. The applicant's amendments are sufficient to overcome the claim objections of the last office action, which are hereby **withdrawn**.

In view of the amendment dated October 6, 2000, the following new grounds of rejection apply:

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

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- a) Claim 6 is vague and indefinite in that the dependent claim is not further limiting of the claim from which it depends.

4. Applicants' attention is directed to U.S. Patent No. 5,981,528, which while not competent as a reference against the instant claims, claims subject matter that is similar and/or identical to that claimed herein. Two patents cannot issue on the same subject matter, unless applicants can demonstrate that the claims are patentably distinct from the claims of this US patent, the only way to overcome this patent is by way of Interference proceedings or removal of the conflicting subject matter. See MPEP 2306. Claims 1-5, 8 and 11-15 are in condition for allowance, however, two patents cannot issue to the same subject matter. **Applicants are required to amend the claims to overcome the reference or copy the claims for interference purposes.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Monday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
Brenda Coleman  
October 27, 2000